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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,281	06/20/2003	Peter Strarup Jensen	SUNMP155	6348

  

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MARTINE PENILLA & GENCARELLA, LLP		
710 LAKEWAY DRIVE		
SUITE 200		
SUNNYVALE, CA 94085		

  

EXAMINER	
NGUYEN, DUSTIN	

  

ART UNIT	PAPER NUMBER
2154	

  

MAIL DATE	DELIVERY MODE
06/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/600,281	<b>Applicant(s)</b> JENSEN ET AL.	
	<b>Examiner</b> Dustin Nguyen	<b>Art Unit</b> 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1 – 20 are presented for examination.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It appears claim 1 would reasonably be interpreted by one of ordinary skill as a software per se, failing to fall within a statutory category of invention. "A provisioning application" is not a machine, and it is clearly not a process, manufacture nor composition of matter, and as such the claim is not patentable [ Please see "Interim Guideline for Examinations of Patent Applications", MPEP 2106 ].

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. [ US Patent Application No 2002/0131404 ]; in view of Kloba et al. [ US Patent No 6,341,316 ].

5. As per claim 1, Mehta discloses the invention as claimed including a provisioning application for provisioning services between a client and a provisioning server [ i.e. methods and systems for maintaining and provisioning wireless applications ] [ Figure 1; Abstract; paragraphs 0005 and 0012 ], comprising:

discovery transactions that allow a client device to retrieve information regarding services available to the client device from a provisioning server [ i.e. the MAS to retrieve a list of available applications that can be downloaded to the subscriber's device, this is referred to application discovery ] [ Figure 4; and paragraphs 0006, 0067 and 0070 ], wherein a service comprises a plurality of content files capable of being installed on the client device [ i.e. installation or uninstallation of applications on the wireless device ] [ paragraphs 0063 and 0064 ];

subscription transactions that allow the client device to manage content in service directories [ i.e. a Personalization Website, which is used by subscribers to order, ... and to manage applications ] [ paragraphs 0091, 0115 and 0116 ], wherein a service directory comprises a plurality of services [ paragraphs 0091, 0131 ].

Mehta does not specifically disclose

delivery transactions that allow the client device to download data related to services based on synchronization of the client device with the provisioning server, wherein the

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synchronization ensures that view of delivered services on the client is in synchronization with the view of the delivered services on the provisioning server.

Kloba discloses

delivery transactions that allow the client device to download data related to services based on synchronization of the client device with the provisioning server [ i.e. the web synchronization module controls synchronization of web content to client ] [ Figures 1I1 and 1I2; col 9, lines 1-14; and col 14, lines 46-53 ], wherein the synchronization ensures that view of delivered services on the client is in synchronization with the view of the delivered services on the provisioning server [ i.e. data on the client and server are the same ] [ col 5, lines 29-40; and col 19, lines 33-col 20, lines 3 ].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Mehta and Kloba because the teaching of Kloba on synchronization would enable applications available via a network or via an Internet/intranet to download and to run on mobile devices and manage the variables relevant to a mobile device/server environment [ Kloba, col 4, lines 45-52 ].

6. As per claim 2, Mehta discloses wherein the discovery transactions includes a service discovery transaction that allows the client device to obtain information regarding a particular service [ i.e. application discovery returns a list of content that can be downloaded that match criteria ] [ Figure 4; and paragraphs 0006 and 0067 ].

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7. As per claim 3, Mehta discloses wherein the discovery transactions include a service directory discovery transaction that allows the client device to obtain information regarding a particular service directory [ i.e. A subscriber's Personal Access List is the list of applications that the subscriber desires to have the MAS display during application discovery ] [ paragraphs 0016, 0019 and 0020 ].

8. As per claim 4, Mehta discloses wherein the subscription transactions include a service subscription transaction that allows a service to be added to a service directory [ i.e. adding applications ] [ Figures 11E-H; paragraphs 0116 and 0117 ].

9. As per claim 5, Mehta discloses wherein the subscription transactions include an unsubscribe transaction that allows a service to be removed from a service directory [ i.e. removing applications ] [ Figure 11J; and paragraphs 0116 and 0118 ].

10. As per claim 6, Mehta discloses wherein the delivery transactions include an update transaction that allows that allows the client device to obtain a provisioning update comprising a list of services that should be installed on the client device [ i.e. a list of new applications that can be potentially downloaded ] [ paragraph 0063 ].

11. As per claim 7, Mehta discloses wherein the delivery transactions include a notification transaction that allows the provisioning server to request the client device to perform an update

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transaction [ i.e. a notification that an updated version is available ] [ paragraphs 0063 and 0110 ].

12. As per claim 8, Mehta discloses wherein the delivery transactions include a delivery transaction that allows the client device to download data related to a service [ i.e. send the packaged application to the requesting subscriber device ] [ 310, Figure 3; and paragraphs 0070 and 0131 ].

13. As per claims 9-16, they are method claimed of claims 1-8, they are rejected for similar reasons as stated above in claims 1-8.

14. As per claims 17-20, they are apparatus claimed of claims 1-8, they are rejected for similar reasons as stated above in claims 1-8.

15. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen

Examiner

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A handwritten signature in black ink, appearing to read 'Dustin', with a long, sweeping horizontal stroke extending to the right.